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**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

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*Ex parte* DEAN L. RHOADES

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Appeal 2007-1611
Application 09/802,425
Technology Center 1600

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DECIDED: February 26, 2008

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Before TONI R. SCHEINER, DONALD E. ADAMS, and LORA M. GREEN, *Administrative Patent Judges*.

SCHEINER, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellant appeals under 35 U.S.C. § 134 from a final rejection of claims 1-3, 5, 7, and 21-23, all the claims remaining in the application. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

## STATEMENT OF THE CASE

The claimed invention is directed to a composition, "suitable as an exfoliator to improve the look and feel of an area of human skin" (Spec. 3). Claims 1, 5, 21, and 23 are representative:

1. A composition comprising:
a base comprising at least about twenty three percent by weight a moisturizer suitable for application to human skin; and
a plurality of abrasive particles having a particle size in the range of 50 microns to 556 microns.

5. A composition comprising:
a base in the form of a cream suitable for application to human skin; and
a plurality of particles of corundum suspended in the base having an average particle size from 34 to 124 microns, and
wherein the plurality of particles of corundum are at least thirty five percent by weight of the composition.

21. The composition of claim 1, wherein the composition may be left on the skin after application.

23. The composition of claim 1, wherein the plurality of abrasive particles are at least thirty five percent by weight of the composition.

The Examiner relies on the following references:

| | | |
|---|---|---|
| Saperstein | US 3,092,111 | Jun. 4, 1963 |
| McLaughlin | US 3,852,417 | Dec. 3, 1974 |
| Stiefel | US 4,957,747 | Sep. 18, 1990 |
| McAtee | US 5,607,980 | Mar. 4, 1997 |
| Wdowik | US 5,756,081 | May 26, 1998 |
| Messenger (filed Apr. 6, 2000) | US 6,290,976 B1 | Sep. 18, 2001 |
| Lee | US 6,294,179 B1 | Sep. 25, 2001 |
| Fox (filed Oct. 5, 2001) | US 2002/0090385 A1 | Jul. 11, 2002 |

The claims stand rejected as follows:[1]

- Claims 1-3, 5, 7, and 21-23 under 35 U.S.C. § 112, first paragraph, as incorporating new matter.

- Claims 1-3, 5, 7, and 21-23 under 35 U.S.C. § 102(e), as anticipated by or, under 35 U.S.C. § 103(a) as obvious over Messenger.

- Claims 1, 2, 21, and 22 under 35 U.S.C. § 102(b), as anticipated by or, under 35 U.S.C. § 103(a) as obvious over Lee.

- Claims 1-3 and 21-23 under 35 U.S.C. § 102(b), as anticipated by or, under 35 U.S.C. § 103(a) as obvious over Saperstein.

- Claims 1-3 and 21-23 under 35 U.S.C. § 102(b), as anticipated by or, under 35 U.S.C. § 103(a) as obvious over Stiefel.

- Claims 5 and 7 under 35 U.S.C. § 103(a) as unpatentable over Fox.

- Claims 1-3, 21, and 22 under 35 U.S.C. § 103(a) as obvious over McAtee.

- Claims 1, 2, 21, and 22 under 35 U.S.C. § 102(b), as anticipated by or, under 35 U.S.C. § 103(a) as obvious over Wdowik.

- Claims 1-3, 5, 7, and 21-23 under 35 U.S.C. § 103(a) as unpatentable over McLaughlin and in view of Wdowik.

## FINDINGS OF FACT[2]

[1] A rejection of claims 1-3 and 21-23 under 35 U.S.C. § 112, second paragraph, and a rejection of claims 1-3, 5, 7, 21 and 22 under 35 U.S.C. § 103(a) as obvious over Imamura (U.S. Patent 4,284,533), were withdrawn by the Examiner (Ans. 2-3).

[2] Abbreviated "FF".

*Appellant's Disclosure*

1. The invention is directed to a "composition . . . including a base and a plurality of abrasive particles" (Spec. ¶ 12).

2. The base "is capable of suspending the plurality of abrasive particles within the base" and "a principal component in the base, is a moisturizer" (Spec. ¶ 14).

3. "Suitable moisturizers may be in various forms as known in the art. Such forms include but are not limited to, liquids, including but not limited to, creams, gels, pastes and emol[l]ients" (Spec ¶ 15).

4. The Specification does not define the term "moisturizer," but does indicate that the term "moisturizer" includes humectants "that attract[ ] moisture to the top skin layer" (Spec ¶ 14), and also includes "substances that tend to reduce water loss by creating a barrier" (Spec ¶ 14). Water is "moisture," but is not a "moisturizer" as that term is used in the Specification.

5. "Suitable humectants include glycerin, propylene glycol, alpha hydroxy acids, urea, and lactic acid" (Spec. ¶ 14). Suitable barrier moisturizers include "petrolatum, mineral oil, lanolin and silicone derivatives" (*id.*).

6. "In addition to the moisturizer, the base of the composition may further include . . . antioxidants, aromas/fragrances, vitamins (particularly vitamins A, C and E), emulsifiers, toners, acids (e.g., glycolic acid), scrubs, serums, lotions, liquids, elixirs, sun screens, and tonics" (Spec. ¶ 15).

7. "Suitable abrasive particles include inorganic particles such as corundum, aluminum oxide, alumina, $Al_2O_3$ and magnesium oxide (MgO).

In one embodiment, the abrasive particles are microcrystals of corundum having an average particle size on the order of 34 microns (μm) to 556 μm (320 to 30 grit). More preferably, the average particle size of the microcrystals is on the order of about 42 μm to 198 μm (280 to 60 grit)" (Spec. ¶ 12).

8. The Specification describes "a suitable composition including corundum (alumina) microcrystals and a cream moisturizer at approximately 14 grams microcrystals per ounce of cream" as follows (Spec. ¶ 19):

| Ingredients | Percentage |
|---|---|
| Aluminum Oxide | 35.000 |
| Purified Water | 14.288 |
| Caprylic/Capric Triglyceride | 11.500 |
| Octyl Palmitate | 10.000 |
| Safflower Oil | 10.000 |
| Cetearyl Alcohol | 3.000 |
| Sodium Cetearyl Sulfate | 2.100 |
| Stearic Acid | 3.000 |
| Wheat Germ Oil | 3.000 |
| Propylene Glycol | 2.900 |
| Panthenol | 1.000 |
| Lecithin | 0.500 |
| Cetyl Alcohol | 0.500 |
| Tocopheryl Acetate (vitamin E) | 0.100 |
| Retinyl Palmitate (vitamin A) | 0.100 |
| Ascorbyl Palmitate | 0.100 |
| Extract of Carrot | 0.050 |
| Wheat Germ | 0.050 |
| Wheat Bran | 0.050 |
| Aminomethyl Propanediol | 0.050 |
| Beta Carotene | 0.010 |
| Methylparaben | 0.200 |
| Propylparaben | 0.100 |
| Phenoxyethanol | 0.200 |
| FDC Yellow 5 | 0.001 |
| FDC Yellow 6 | 0.001 |
| Fragrance | 0.200 |

*The Rhoades Declaration*[3]

[3] Exhibit C of the Evidence Appendix accompanying the Brief, Declaration of Dean L. Rhoades, and originally submitted September 13, 2004, under the provisions of 37 C.F.R. §1.131, and dated September 7, 2004 (hereinafter

9. The Rhoades Declaration was submitted to establish that "[t]he invention . . . was reduced to practice in the United States of America at least as early as September 15, 1998" (Rhoades Decl. ¶ 8).

10. The Rhoades Declaration refers to "printouts of two formulations (Exhibit A and B[4])." According to the Declarant (Appellant), "Exhibit A is a formulation of a cream base having moisturizer ingredients that are twenty percent by weight of the base. Exhibit B is a formulation of a composition with the cream base of Exhibit A and aluminum oxide with a particle size of 120 microns" (Rhoades Decl. ¶ 8).

11. The twenty percent moisturizer figure is calculated based on the weight of the cream base (Exhibit A), not on the weight of the composition (Exhibit B) containing both the base and the abrasive particles (aluminum oxide).

12. The base also contains various components, including vitamins (e.g., vitamin A and vitamin E acetate, and emulsifiers (e.g., lecithin).

13. The aluminum oxide particles are 50% by weight of the final composition (Exhibit B).

*Messenger*

14. Messenger describes a "compound for dermabrading, conditioning, rejuvenating and moisturizing facial skin. The form of [the] composition is

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"Rhoades Declaration" or "Rhoades Decl.").

[4] Exhibits A ("Microderm Abrasion Cream base") and B ("Microdermabrasion Cream") of the Evidence Appendix accompanying the Brief, and originally submitted September 13, 2004 with the Rhoades Declaration.

either a cream or paste uniformly blended with all ingredients being substantially uniformly distributed therethrough" (Messenger, col. 3, ll. 3-7).

15. Messenger's composition comprises, among other things, 56% mineral oil and 40% corundum (Messenger, Example I). The corundum is "in the range of preferably about 120 FEPA (Federal European Abrasive Producers) standard or about 125 microns" (Messenger, col. 3, ll. 43-45).

16. Messenger does not claim the same invention as presently claimed.

*Lee*

17. Lee describes "a viscous, liquid, skin washing composition comprising water, at least one surface active agent, suspended, abrasive particles and a viscosifier" (Lee, col. 1, ll. 57-59).

18. "The presence of abrasive particles . . . [with] a mean diameter of 40-400 microns and a specific gravity in the range 1-4 is an essential element" of the composition (Lee, col. 2, ll. 14-16). "Calcite (3 Moh) particles are most particularly preferred" and "[p]referred products comprise 5-15% wt. of mineral particles, more preferably around 10% wt." (Lee, col. 2, ll. 32-37).

19. The viscosifier is "preferably a swelling clay, more preferably a synthetic hectorite (laponite) clay" (Lee, col. 3, ll. 12-14).

*Saperstein*

20. Saperstein describes "a therapeutic abrasive composition having the physical characteristics of a paste" (Saperstein, col. 2, ll. 46-47), "which comprises essentially a non-oleaginous [i.e., non-oily] detergent base having dispersed therein an inorganic abrasive [e.g., aluminum oxide] . . . having a

particle size distribution within the range of about 125 microns to about 710 microns" (Saperstein, col. 2, ll. 66-71).

21. Sapersteins's composition is designed for "abrasion of the skin for the treatment of acne" (Saperstein, col. 1, l. 12), and also "function[s] as a detergent and emulsifying agent for the oily sebum of the skin" (Saperstein, col. 5, ll. 43-44). The composition is applied to dry skin, scrubbed with a rotary motion for ten counts, and washed off with hot water daily, "until dryness, redness, and desquamation occur" (Saperstein, col. 8, ll. 53-61).

22. The composition described in Saperstein's Example 4 contains a mixture of three soaps and one synthetic surfactant (totaling 26%), water (60.6%), and three emollients (i.e., moisturizers), totaling 13.4% (lanolin (0.5%), polyethylene glycol (10.1%), and glycerine (2.8%)). (Saperstein, col. 7, ll. 1-10).

*Stiefel*

23. Stiefel describes a "topical composition . . . fluid in nature, typically a paste, which can be readily dispensed and rubbed on the skin . . . [which] contain[s] from about 35% to about 65%, by total weight of the composition, of fine aluminum oxide [i.e., corundum] particles. Typically the majority of the aluminum oxide particles, that is 80% or more, will have a particle size ranging from 170μ to 600μ with 40 to 50% falling in the 250μ to 420μ range" (Stiefel, col. 1, ll. 36-43).

24. "The aqueous base of the composition will comprise from about 5% to about 10%, by total weight of the composition . . . of at least one emollient. The emollient will include at least one [ ] member, and preferably several members, selected from the group consisting of polyethylene glycol,

fatty acid esters of polyols, dimethicone, and alkyl esters of fatty acids" (Stiefel, col. 1, ll. 44-51). "In addition, other excipients can be present, as for example humectants such as glycerine" (Stiefel, col. 1, ll. 64-65).

25. Stiefel's Example 1 contains 38.02% aluminum oxide and several moisturizers (PEG 75, glyceryl stearate/PEG 100 stearate, dimethicone, octyl hydroxystearate, and glycerine) totaling 9.3192% by weight of the composition, and 15.0358% of the base (Stiefel, col. 2, ll. 15-36).

26. Stiefel's composition is "applied topically several times daily with a slight rubbing action" (Stiefel, col. 2, ll. 5-6), and "is not intended to produce severe irritation, dryness, or redness" (Stiefel, col. 2, ll. 8-9).

27. Stiefel's composition is "rubbed into the skin" (Stiefel, col. 3, l. 13). There is no indication that it is washed off after application.

*Fox*

28. Fox describes a "crystalline emulsion" comprising a carrier in the form of a "gel, lotion, thick solution, cream, paste, wax, or like substance" (Fox ¶ 25), and containing "magnesium oxide crystals, [and/or] aluminum oxide crystals" (Fox ¶ 12), "of a particle size about 40-2000 microns, preferably about 100-1200 microns, most preferably about 600-800 microns" (Fox ¶ 13). The "crystal to carrier ratio is within the range of about 2%-99%, preferably about 50%" (Fox ¶ 25).

29. "Additional compounds may be added to the crystalline emulsion, including, including vitamin C, vitamin E . . . [and] moisturizers" (Fox ¶ 26).

30. Fox does not claim the same invention as presently claimed.

*McAtee*

31. McAtee describes compositions "useful for conditioning the skin, for desquamating the skin, [and] for treating dry skin" (McAtee, col. 3, ll. 44-46), "formulated into a wide variety of product types including . . . creams, lotions, mousses, sprays, 'rinse-off' cleansers, 'water-less' cleansers . . . and the like" (McAtee, col. 4, ll. 4-7).

32. McAtee's compositions comprise amphoteric, cationic, and anionic surfactants, water, and optionally, "one or more humectants or moisturizers . . . each [of which] can be present at a level of from about 0.1% to about 20%, more preferably from about 0.5% to about 15%, and most preferably from about 1% to about 10%" (McAtee, col. 13, ll. 42-47), and "from about 0.1% to about 20%, more preferably from about 0.25% to about 15%, and most preferably from about 0.5% to about 10%, based on the weight of the total composition, of insoluble particles which are useful for enhancing the cleansing effect, when the compositions . . . are in the form of a cleansing composition" (McAtee, col. 13, l. 66 to col. 14, l. 5).

33. McAtee teaches that both micronized and conventional sized insoluble particles are useful in the compositions (McAtee, col. 14, ll. 14-15). "The conventional size particles are tactilely perceptible and are added for the scrubbing and abrasive effect which they provide" (McAtee, col. 14, ll. 17-19). The micronized particles, "derived from a wide variety of materials including . . . inorganic, organic, natural, and synthetic sources" (McAtee, col. 14, ll. 46-48), "should have a mean particle size diameter from about 1 to about 75 microns, more preferably from about 15 to about 60 microns" (McAtee, col. 14, ll. 38-41).

34. According to McAtee, suitable micronized particles are those that are "essentially *non-abrasive* to the skin" (McAtee, col. 14, ll. 15-17 (emphasis added)).

*Wdowik*

35. Wdowik describes shaving compositions containing insoluble particulate additives, including abrasives like silica and aluminum oxide (Wdowik, col. 3, ll. 55-57, and col. 6, ll. 49-64).

36. Wdowik's compositions may be in "solid, gel, cream, liquid or aerosol" form (Wdowik, col. 3, ll. 13-14). "'[A]n effective amount' of insoluble particulate additives is an amount, by weight, which provides physical support for the blade of a razor . . . In most instances, from about 0.1% to about 20%, by weight will be adequate, while from about 1% to about 10%, by weight is normally preferred. However, . . . in thick pastes, solids, and gels even as high as 90% or greater may be used" (Wdowik, col. 3, ll. 42-52).

37. Wdowik describes a specific composition comprising 3% "silica sand . . . nominally about 75 μm in size", and a base (the composition minus the silica sand) containing 21.53% moisturizers by weight (i.e., mineral oil (17%), coconut fatty acid (0.68%), and glycerine (3.20)) (Wdowik, Example 2, col. 5, l. 66 to col. 6, l. 21).

38. There is no evidence of record that Wdowik's shaving compositions can be left on the skin after application.

*McLaughlin*

39. McLaughlin describes a shaving composition containing moisturizers, but no abrasive particles (McLaughlin, *passim*).

DISCUSSION

*New Matter*

The Examiner rejected claims 1-3, 5, 7, and 21-23 under the first paragraph of 35 U.S.C. § 112, as incorporating new matter.

The Examiner contends that the limitation "a base comprising at least about twenty three percent by weight a moisturizer" in claims 1-3 and 21-23 is new matter (Ans. 4).

Appellant argues that "[t]he example provided at paragraph 19 describes one embodiment of a composition, including . . . at least 23% moisturizers" (Br. 16). Specifically, "[p]aragraph 19 of the Application provides one example of a composition, including octyl palmitate (10%), safflower oil (10%), and propylene glycol (2.9%), each of which has a property of a moisturizer. The composition also includes panthenol (1%), which has humectant properties" (Br. 15).

According to the Examiner, however, the composition described in the table at ¶ 19 of the Specification has a combined percentage of moisturizers of 22.9% or 23.9% by weight of the *composition* (depending on whether 1% panthenol is included among the moisturizers), rather than the *base*, as required by the claims. The Examiner argues that the base and abrasive particles are discrete components of the composition, and when the moisturizers are expressed as a percentage of the composition *minus* the abrasive particles (35.00 by weight), they actually make up a much higher percentage of the base than 22.9% (Ans. 4-6).

Appellant contends "[n]owhere within the language of claim 1 is it recited that the base may not include abrasive particles such as aluminum oxide. . . . [and] the Patent Office has not pointed to a portion of Appellant's specification expressly requiring the terms 'composition' and 'base' as recited in the claims to be construed differently or preventing them from being used interchangeably" (Reply Br. 3).

Appellant's argument is not persuasive. Claims are interpreted in light of the Specification. In this case, the Specification states that the moisturizer is a "component" of the base (Spec. ¶ 14; FF 2), and "the base of the composition may further include, but is not limited to, antioxidants, aromas/fragrances, vitamins (particularly vitamins A, C and E), emulsifiers, toners, acids (e.g., glycolic acid), scrubs, serums, lotions, liquids, elixirs, sun screens, and tonics" (Spec. ¶ 15; FF 6). Abrasive particles are never mentioned as a "component" of the base in the way that the moisturizer is, and are not listed among the other substances that may make up part of the base. Instead, the Specification discloses a "composition . . . including a base *and* a plurality of abrasive particles" (Spec. ¶ 12 (emphasis added); FF 1), and also teaches that "abrasive particles of corundum (alumina) microcrystals are *combined* with a creme moisturizer base" (Spec. ¶ 17 (emphasis added)). The implication is that the base is a discrete component that is mixed with abrasive particles to form the final composition.

Moreover, the proportion of abrasive particles (aluminum oxide microcrystals) in the composition shown at ¶ 19 of the Specification is expressed in two ways: in relation to the finished composition, and also in relation to the "cream moisturizer." That is, aluminum oxide is listed as

35% by weight of the total composition in the Table in ¶ 19 (i.e., 35 grams of microcrystals in 100 grams of the composition). But the Specification also indicates there are "approximately 14 grams microcrystals per ounce of cream" (Spec. ¶ 19; FF 8), i.e., approximately 14 grams of microcrystals per 28.34 grams of cream. Assuming that "cream moisturizer" as it is used in ¶ 19 is the same as "cream moisturizer base" in ¶ 17, the two expressions can only be reconciled if the terms "composition" and "base" are *not* used interchangeably in the Specification, and the abrasive particles are a component of the composition, but *not* of the base.

Finally, we note that the Rhoades Declaration refers to "two formulations (Exhibit A and B)." According to the Declarant (Appellant), "Exhibit A is a formulation of a cream base having moisturizer ingredients that are twenty percent by weight of the base. Exhibit B is a formulation of a composition with the cream base of Exhibit A and aluminum oxide with a particle size of 120 microns" (Rhoades Decl. ¶ 8). The twenty percent figure is calculated based on the weight of the cream base of Exhibit A, not on the weight of the composition containing both the base and the abrasive particles (i.e., the aluminum oxide) (FF 10).

Thus, we agree with the Examiner that the limitation "a base comprising at least about twenty three percent by weight a moisturizer" in claims 1-3 and 21-23 is new matter.

The Examiner also contends that the limitations "wherein the plurality of particles of corundum are at least thirty five percent by weight of the composition" in claims 5 and 7, and "wherein the plurality of abrasive

particles are at least thirty five percent by weight of the composition" in claim 23 are new matter (Ans. 4).

If we understand the Examiner's concern, it is that the Specification contains a disclosure of corundum at 35% by weight of the composition, and a disclosure of a composition comprising 20% to 70% corundum by weight, but no disclosure that "[the] amount of corundum or abrasive particles can range from 35% up to but not including 100% of the claimed composition" (Ans. 6).

The written description requirement is satisfied if the disclosure conveys with reasonable clarity to those skilled in the art that the inventor was in possession of the invention. *See Purdue Pharma L.P. v. Faulding, Inc.*, 230 F.3d 1320, 1323 (Fed. Cir. 2000).

In our view, the Examiner's standard is overly stringent, and the Specification conveys with reasonable clarity to those skilled in the art that the inventor was in possession of a composition comprising at least 35% corundum by weight, despite the lack of an articulated upper limit in the claim.

Accordingly, we do not agree that the limitation "at least 35% by weight of the composition" is new matter.

Finally, the Examiner contends that the limitation "a plurality of particles of corundum . . . having an average particle size from 34 to 124 microns" in claims 5 and 7 is new matter (Ans. 4).

The Specification teaches that abrasive particles having an average particle size on the order of 34 microns (μm) to 556 μm (320 to 30 grit), preferably on the order of about 42 μm to 198 μm (280 to 60 grit), are

suitable for the claimed compositions (Spec. ¶ 12; FF 7). Thus, the claimed average particle sizes fall squarely within the limits of the particle sizes explicitly described in the Specification. Again, in our view, the Examiner has applied an overly stringent standard, and one skilled in the art would have understood that Appellant had possession of compositions containing particles having any size between 34 microns and 556 microns.

Accordingly, the rejection of the claims under 35 U.S.C. § 112, first paragraph, is affirmed with respect to claims 1-3 and 21-23, and reversed with respect to claims 5 and 7.

*Messenger*

Claims 1-3, 5, 7, and 21-23 stand rejected under 35 U.S.C. § 102(e) as anticipated by, or under 35 U.S.C. § 103(a) as obvious over, Messenger.

Appellant does not present separate arguments for any particular claim with respect to this rejection, therefore, the claims stand or fall together. We select claim 1 as representative of the subject matter on appeal. 37 C.F.R. § 41.37(c)(1)(vii).

Messenger describes a composition comprising, among other things, 56% mineral oil, and 40% corundum (Messenger, Example I). The corundum is "in the range of preferably about 120 FEPA (Federal European Abrasive Producers) standard or about 125 microns" (Messenger, col. 3, ll. 43-45; FF 15). Therefore, Messenger describes a composition comprising a plurality of abrasive particles having a particle size in the range of 50 microns to 556 microns (i.e., corundum, about 125 microns in diameter), and a base comprising at least about twenty three percent moisturizer (i.e., mineral oil), as required by claim 11.

Appellant argues, correctly, that Messenger does not claim the same invention as presently claimed (Br. 22; FF 16), and relies on a declaration submitted under the provisions of 37 C.F.R. § 1.131, as evidence that the presently claimed invention "was reduced to practice . . . at least as early as September 15, 1998" (Rhoades Decl. ¶ 8), to overcome the rejection over Messenger.

The Rhoades Declaration refers to "printouts of two formulations (Exhibit A and B)" (Rhoades Decl. ¶ 8; FF 10). According to the Declarant (Appellant), "Exhibit A is a formulation of a cream base having moisturizer ingredients that are twenty percent of the base. Exhibit B is a formulation of a composition with the cream base of Exhibit A and aluminum oxide with a particle size of 120 microns" (Rhoades Decl. ¶ 8; FF 10). The specific components of the base that are included in the twenty percent figure are not identified in the Declaration.

In referring to the *same* exhibits in the Brief, Appellant asserts that "at least 22.3 percent of components in the base . . . can be classified as moisturizers: panthenol (0.30); propylene glycol (2.00); dehyhag wax (5.00); safflower oil (6.00); octyl palmitate (7.00); and wheat germ oil (2.00)" (Br. 21).

Appellant has not explained the discrepancy between the 20% calculation in the Declaration, and the 22.3% calculation in the Brief – at the very least, Appellant has not established that dehyhag [sic, dehydag?] wax, which is 5% of the base by weight, is a moisturizer. Therefore, we find that the Rhoades Declaration does not establish reduction to practice of the

invention of claim 1 prior to Messenger's effective filing date, and Messenger is available as prior art.

The rejection of claims 1-3, 5, 7, and 21-23 as anticipated by, or obvious over, Messenger is affirmed.

*Lee*

Claims 1, 2, 21, and 22 stand rejected under 35 U.S.C. § 102(b) as anticipated by, or under 35 U.S.C. § 103(a) as obvious over, Lee.

According to the Examiner, "[t]he carrier in Lee . . . contains a mixture of water, surfactants, hectorite or hectorite and xanthan gum, NaCl which causes the hectorite to swell and . . . [have] the viscosity of a gel" (Ans. 26). The Examiner argues that "the carrier contains swelled hectorite and would add moisture to the skin" (Ans. 26-27), and "[t]he Specification does not exclude water from being included as a component of a moisturizer" (Ans. 26),

The Examiner does not identify anything, other than water, as a moisturizer in Lee's composition. Nor does the Examiner establish that water, in combination with any of the other components of Lee, acts as a moisturizer. Rather, the Examiner appears to argue that the water is a moisturizer because it contains a thickener (hectorite) that gives it the viscosity of a gel. Nevertheless, the Examiner has not established that water itself is a moisturizer (FF 4), or that a substance is a moisturizer simply because it has the consistency of a gel. Moreover, we note that the Examiner did not consider water to be a moisturizer in evaluating the compositions set forth in the Rhoades Declaration and at ¶ 19 of the Specification.

The rejection of claims 1, 2, 21, and 22 under 35 U.S.C. § 102(b) as anticipated by, or under 35 U.S.C. § 103(a) as obvious over, Lee is reversed.

*Saperstein*

Claims 1-3 and 21-23 stand rejected under 35 U.S.C. § 102(b) as anticipated by, or under 35 U.S.C. § 103(a) as obvious over, Saperstein.

The Examiner contends that Saperstein's base contains moisturizers "sodium lauryl sulfate, sodium laurate, sodium myristate, sodium stearate, lanolin, polyethylene glycol, glycerine and water" (Ans. 32-33), that "[e]ven without water . . . add up to 39.4% of the base" (Ans. 33).

We disagree. The only moisturizers in Saperstein's compositions are the emollients lanolin, polyethylene glycol, and glycerine, which make up only 13.4% of the base (and even less of the composition, depending on the weight of the abrasive particles) (FF 22). Sodium stearate is a synthetic surfactant, and sodium lauryl sulfate, sodium laurate, and sodium myristate are soaps (FF 22), all of which function to cleanse and *dry* the skin (FF 21). Again, we note that the Examiner has not established that water itself is a moisturizer (FF 4), and did not consider water to be a moisturizer in evaluating the compositions set forth in the Rhoades Declaration and at ¶ 19 of the Specification.

Accordingly, we find that Saperstein does not anticipate the claimed invention.

We further conclude that it would not have been obvious for one skilled in the art to increase the percentage of emollients (i.e., moisturizers) in Saperstein's composition to the percentage required by the claims,

because Saperstein's composition is intended to promote drying of the skin (FF 21).

The rejection of claims 1-3 and 21-23 under 35 U.S.C. § 102(b) as anticipated by, or under 35 U.S.C. § 103(a) as obvious over Saperstein is reversed.

*Stiefel*

Claims 1-3 and 21-23 stand rejected under 35 U.S.C. § 102(b) as anticipated by, or under 35 U.S.C. § 103(a) as obvious over Stiefel. Appellant presents a separate argument for claim 21, but the remaining claims stand or fall with claim 1.

Stiefel's Example 1 contains 38.020% aluminum oxide in a size range encompassing the claimed range, and an aqueous base containing several moisturizers (PEG 75, glyceryl stearate/PEG 100 stearate, dimethicone, octyl hydroxystearate, and glycerine) totaling 15.0358% of the base (i.e., the composition minus the aluminum oxide) (Stiefel, col. 2, ll. 15-36; FF 23, 25).

However, the rejected claims require "a base comprising at least about twenty three percent by weight a moisturizer" (claim 1), therefore, we find that Stiefel does not anticipate the invention of claims 1-3 and 21-23.

Nevertheless, we agree with the Examiner that the claimed invention would have been obvious over Stiefel.

"The law is replete with cases in which the difference between the claimed invention and the prior art is some range or other variable within the claims." *In re Woodruff*, 919 F.2d 1575, 1578 (Fed. Cir. 1990) (citations omitted). "These cases have consistently held that in such a situation, the

applicant must show that the particular range is *critical*, generally by showing that the claimed range achieves unexpected results relative to the prior art range." *Id.* In addition,

> [i]n order for a showing of "unexpected results" to be probative evidence of non-obviousness, it falls upon the applicant to at least establish: (1) that there actually is a difference between the results obtained through the claimed invention and those of the prior art; and (2) that the difference actually obtained would not have been expected by one skilled in the art at the time of invention.

*In re Freeman*, 474 F.2d 1318, 1324 (CCPA 1973).

Here, the only difference between Stiefel and the claimed invention is the amount of moisturizer in the base (FF 25). Appellant has neither argued nor established that the amount of moisturizer in the composition is critical.

With respect to claim 21, Steifel teaches that the composition is "rubbed into the skin" (Stiefel, col. 3, l. 13), and there is no indication that it is washed off (see, e.g., Stiefel's Examples 3 and 4; FF 27).

The rejection of claims 1-3 and 21-23 under 35 U.S.C. § 103(a) as obvious over Stiefel is affirmed.

*Fox*

Claims 5 and 7 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Fox.

Appellant argues, correctly, that Fox does not claim the same invention as presently claimed (Br. 39; FF 30), and relies on a declaration submitted under the provisions of 37 C.F.R. § 1.131, as evidence that the invention of claims 5 and 7 "was reduced to practice . . . at least as early as

September 15, 1998" (Rhoades Decl. ¶ 8; FF 9), to overcome the rejection over Fox.

Claim 5 is directed to a composition containing a cream base, and at least 35% by weight corundum (aluminum oxide) particles, wherein the particles have an average particle size from 34 to 124 microns. Claim 7 further requires that the composition contain at least one of a vitamin, a mineral, an antioxidant, a cleanser, and an emulsifier.

The Rhoades Declaration refers to "printouts of two formulations (Exhibit A and B)" (Rhoades Decl. ¶ 8, FF 10). According to the Declarant (Appellant), "Exhibit A is a formulation of a cream base . . . Exhibit B is a formulation of a composition with the cream base of Exhibit A and aluminum oxide with a particle size of 120 microns" (Rhoades Decl. ¶ 8). Thus, the composition of Exhibit B has a cream base and contains 50% aluminum oxide by weight, with a particle size of 120 microns (FF 13), and further contains vitamins and emulsifiers, among other things (FF 12).

We find the Rhoades Declaration is sufficient to establish reduction to practice of the invention of claims 5 and 7 prior to the filing date of the Fox reference.

The rejection of claims 5 and 7 under 35 U.S.C. § 103(a) as unpatentable over Fox is reversed.

*McAtee*

Claims 1-3, 21, and 22 stand rejected under 35 U.S.C. § 103(a) as obvious over McAtee.

As discussed above, claim 1 is directed to composition comprising "a base comprising at least about twenty three percent by weight a moisturizer"

and abrasive particles having a particle size in the range of 50 microns to 556 microns. The moisturizer would be something less than twenty three percent by weight of the composition, depending on the amount of abrasive particles in the composition.

McAtee describes compositions containing moisturizers in essentially the required amount, and particles in the required size range (FF 32, 33). However, unlike the claimed invention, which requires abrasive particles, McAtee teaches that micronized particles suitable for the prior art composition "are essentially *non-abrasive* to the skin" (McAtee, col. 14, ll. 15-17 (emphasis added), FF 34).

The rejection of claims 1-3, 21, and 22 under 35 U.S.C. § 103(a) as obvious over McAtee is reversed.

*Wdowik*

Claims 1, 2, 21, and 22 stand rejected under 35 U.S.C. § 102(b) as anticipated by, or under 35 U.S.C. § 103(a) as obvious over Wdowik. Appellant presents a separate argument for claim 21, but the remaining claims stand or fall with claim 1.

Appellant argues that the Examiner has failed to show that Wdowik "teaches or suggests at least the element of 'a base comprising at least about twenty three percent by weight a moisturizer suitable for application to the human skin' as recited in Claim 1" (Br. 42), and is "[p]resumably . . . including water to meet this limitation" (*id.*).

This argument is not persuasive. Wdowik describes a composition comprising 3% "silica sand . . . nominally about 75 µm in size", and a base (the composition minus silica sand) containing about 21.53% moisturizers

by weight (i.e., mineral oil (17%), coconut fatty acid (0.68%), and glycerine (3.20)) (Wdowik, Example 2, col. 5, l. 66 to col. 6, l. 21; FF 37).

We find that Wdowik's composition anticipates the invention of claim 1, as it contains about 21.53% moisturizers by weight of the base (without including water), which is "at least about twenty three percent," and also contains abrasive particles in the claimed range.

In any case, as discussed above, "[t]he law is replete with cases in which the difference between the claimed invention and the prior art is some range or other variable within the claims." *Woodruff*, 919 F.2d at 1578 (citations omitted). "[I]n such a situation, the applicant must show that the particular range is *critical*, generally by showing that the claimed range achieves unexpected results relative to the prior art range." *Id.*

Thus, even if 21.53% were not "at least about twenty three percent," Appellant has neither argued nor established that the amount of moisturizer in the composition is critical. Therefore, we find that the claimed invention would have been obvious over Wdowik, even if not anticipated outright.

With respect to claim 21 however, we note Wdowik's composition is intended for shaving, and we agree with Appellant that the Examiner has not established that the composition could be left on the skin after application (Wdowik, *passim*; FF 38).

The rejection of the claims under 35 U.S.C. § 102(b) as anticipated by, or under 35 U.S.C. § 103(a) as obvious over Wdowik is affirmed with respect to claims 1, 2, and 22, but reversed with respect to claim 21.

*McLaughlin and Wdowik*

Claims 1-3, 5, 7, and 21-23 stand rejected under 35 U.S.C. § 103(a) as unpatentable over McLaughlin and in view of Wdowik. Appellant presents separate arguments for claims 5, 7, and 21, but the remaining claims stand or fall with claim 1.

McLaughlin describes a shaving composition containing moisturizers in the claimed amounts, but no abrasive particles (FF 39). Wdowik, as it applies to claim 1, is discussed above. We have already determined that claim 1 is anticipated by, and/or obvious over Wdowik.

Therefore, we agree with the Examiner that the invention of claims 1-3, 22, and 23 would have been unpatentable over McLaughlin and in view of Wdowik.

With respect to claims 5 and 7, however, Appellant argues that the references neither teach nor suggest a composition comprising a cream base and corundum particles at least 35% by weight of the composition.

As discussed above, claim 5 is directed to a composition containing a cream base, and at least 35% by weight corundum (aluminum oxide) particles, wherein the particles have an average particle size from 34 to 124 microns.

Wdowik describes shaving compositions containing insoluble particulate additives, including abrasives like silica and aluminum oxide (Wdowik, col. 3, ll. 55-57, and col. 6, ll. 49-64; FF 35). Wdowik teaches that the compositions may be in "solid, gel, cream, liquid or aerosol" form (Wdowik, col. 3, ll. 13-14; FF 36). According to Wdowik, "'an effective amount' of insoluble particulate additives is an amount, by weight, which

provides physical support for the blade of a razor . . . In most instances, from about 0.1% to about 20%, by weight will be adequate, while from about 1% to about 10%, by weight is normally preferred. However . . . in thick pastes, solids, and gels even as high as 90% or greater may be used" (Wdowik, col. 3, ll. 42-52; FF 36).

Essentially, Wdowik teaches that the higher percentages of abrasive particles are not suitable for shaving compositions which are not in the form of a thick paste, solid, or gel (FF 36). Therefore, we agree with Appellant that it would not have been obvious to increase the percentage of abrasive particles in Wdowik's cream formulations to at least 35% by weight.

With respect to claim 21, we find that the Examiner has not established that either McLaughlin's or Wdowik's composition can be left on the skin after application (FF 38, 39).

The rejection of the claims under 35 U.S.C. § 103(a) as unpatentable over McLaughlin and in view of Wdowik is affirmed with respect to claims 1-3, 22, and 23, but reversed with respect to claims 5, 7, and 21.

SUMMARY

- The rejection of claims 1-3, 5, 7, and 21-23 under 35 U.S.C. § 112, first paragraph, as incorporating new matter is AFFIRMED with respect to claims 1-3 and 21-23, and REVERSED with respect to claims 5 and 7.

- The rejection of claims 1-3, 5, 7, and 21-23 under 35 U.S.C. § 102(e), as anticipated by or, under 35 U.S.C. § 103(a) as obvious over Messenger is AFFIRMED.

- The rejection of claims 1, 2, 21, and 22 under 35 U.S.C. § 102(b), as anticipated by or, under 35 U.S.C. § 103(a) as obvious over Lee is REVERSED.

- The rejection of claims 1-3 and 21-23 under 35 U.S.C. § 102(b), as anticipated by or, under 35 U.S.C. § 103(a) as obvious over Saperstein is REVERSED.

- The rejection of claims 1-3 and 21-23 under 35 U.S.C. § 102(b), as anticipated by or, under 35 U.S.C. § 103(a) as obvious over Stiefel is AFFIRMED.

- The rejection of claims 5 and 7 under 35 U.S.C. § 103(a) as unpatentable over Fox is REVERSED.

- The rejection of claims 1-3, 21, and 22 under 35 U.S.C. § 103(a) as obvious over McAtee is REVERSED.

- The rejection of claims 1, 2, 21, and 22 under 35 U.S.C. § 102(b), as anticipated by or, under 35 U.S.C. § 103(a) as obvious over Wdowik is AFFIRMED with respect to claims 1, 2, and 22, and REVERSED with respect to claim 21.

- The rejection of claims 1-3, 5, 7, and 21-23 under 35 U.S.C. § 103(a) as unpatentable over McLaughlin and in view of Wdowik is AFFIRMED with respect to claims 1-3, 22, and 23, and REVERSED with respect to claims 5, 7, and 21.

AFFIRMED

saj

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